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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,866	09/09/2003	Mark A. Reiley	9448.17205-CIP DIV 2	2080
26308	7590	11/15/2005	EXAMINER	
RYAN KROMHOLZ & MANION, S.C.			ISABELLA, DAVID J	
POST OFFICE BOX 26618			ART UNIT	
MILWAUKEE, WI 53226			PAPER NUMBER	
			3738	
DATE MAILED: 11/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,866

Applicant(s)

REILEY, MARK A.

Examiner

DAVID J. ISABELLA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 22-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/03; 11/04; 3/05; 8/05

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 2-4, as worded, positively claims the body.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5,7,8,10-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Carignan et al (4955916).

Carignan et al discloses a prosthesis configured to replace all or a portion of a joint comprising a prosthesis body accomdating fixation to the bone, and an artificial joint structure carried by the prosthesis body adapted and configure to replace all or a portion of the joint. The claim, as worded, is structurally non-descriptive but relies on functional characteristics for defining the structure. Based on the figures, especially figure 12, the components as illustrated is similar to that as disclosed by Carignan,et al. There is nothing in the structure of Carignan, et al that would preclude its use in the

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replacement of the facet joint of the vertebra. Accordingly, the structure as broadly claimed fails to distinguish over the same structure as disclosed by Carignan et al.

Claim 2, the prosthesis of Carignan et al is adapted to be installed in a bone.

Claim 3, Carignan et al provides a threaded portion for attaching (ie. screwing) the prosthesis to the bone.

Claim 4, see stems on each component of Carignan et al.

Claim 5, see element 44.

Claim 7, see element 44.

Claim 8, see elements 48 and 50.

Claims 10-19, see shrink fit and morse taper of the elements supra.

Claims 20 and 21, see columns 2 and 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carignan et al (4955906) as applied to claim 1 above, and further in view of Lal Sachdeva et al (5584695).

The use of adhesive/cement or threads for affixing a prosthesis to the bone is taught by Lal Sachdeva et al. The two means for fixation are well known in the art and

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are generally considered to be equivalent forms for affixing a prosthesis body to the prepared bone depending on surgical considerations. To affix the prosthesis of Carignan et al to the bone with the use of cement/adhesive in place of threaded means would have been obvious to one with ordinary skill in the art based on the doctrine of equivalence.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carignan et al (4955906) as applied to claim 1 above, and further in view of Tullos et al (5658338).

The use of adhesive/cement in place of frictional fit for affixing a prosthesis component to another complementary component is taught by Tullos et al. The two means for fixation are well known in the art and are generally considered to be equivalent forms for affixing a prosthesis body to a complementary component depending on surgical and design considerations. To affix the subcomponents of Carignan et al with the use of cement/adhesive in place of frictional means would have been obvious to one with ordinary skill in the art based on the doctrine of equivalence.

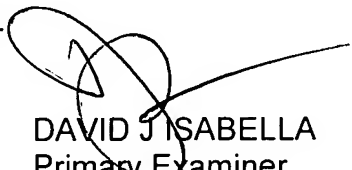
Allowable Subject Matter

Claims 22-24 are objected to as being dependent upon a rejected base claim. The claim utilized dependency as a short hand version to include the structure of the device as set forth in claim 1. The claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. ISABELLA whose telephone number is 571-272-4749. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID J ISABELLA
Primary Examiner
Art Unit 3738

DJI
11-09-05